

Neifeld Docket No: PIP114MANSPCTUS

Application/Patent No: 10/501,141

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Inventor/title: Mansfield/Product Recall Communication

Examiner/ArtUnit: 3622

ENTITY STATUS: LARGE

PRIORITY: This application is a U.S. national stage of PIP-114-MANS-PCT, application PCT/US02/08236, filed 4/4/2002, published as WO 03/085578

37 CFR 41.37 APPEAL BRIEF

I. 37 CFR 41.31(A) AND (B)

Claims have been twice and now finally rejected. A notice of appeal is filed herewith. The fee for the Notice and Brief are paid concurrently via EFS credit card submission. The appeal is within the time period provided by 1.134.

II. 37 CFR 41.37(C)(1)

The brief contains the items of (c)(1) under appropriate headings and in the order indicated by sub paragraphs (i) - (x).

III. 37 CFR 41.37(C)(1)(I) - REAL PARTY IN INTEREST

The real party in interest is Catalina Marketing Corporation, a Delaware corporation.

IV. 37 CFR 41.37(C)(1)(II) - RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

V. 37 CFR 41.37(C)(1)(III) - STATUS OF CLAIMS

"A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed."

Claims 1-58 are in this proceeding.

Claims 1, 2, 4, 6-9, 11, 25-51 are canceled.

Claims 3, 5, 10, 12-23, and 52-58 are pending.

Claims 3, 5, 10, 12-23, and 52-58 are rejected and appealed.

VI. 37 CFR 41.37(C)(1)(IV) - STATUS OF AMENDMENTS

"A statement of the status of any amendment filed subsequent to final rejection."

No amendment was filed subsequent to final rejection.

VII. 37 CFR 41.37(C)(1)(V) - SUMMARY OF CLAIMED SUBJECT MATTER

Claim 3 defines a computer network implemented method for recalling product items for a product subject to a recall (page 1 lines 25-26), comprising:

determining, in a computer system (page 5 line 30, Figure 1 element 10), a CID associated with a product identification of said product subject to said recall (page 5 lines 30-32, Figure 1 element 20, Figure 2 element 240), thereby indicating prior purchase by a person associated with said CID of a first product item of said product (page 5 line 30 through page 6 line 8); and

thereafter, in response to identifying at a terminal or kiosk of a retail store computer system (page 6 lines 32-33; Figure 1 elements 10, 20, 30, 100), said CID (page 6 lines 32-33; Figure 2 element 240), thereby indicating the presence of said person at said terminal or kiosk (page 6 lines 32-33), providing to said person via said terminal or kiosk a notification of said recall for said product and offering to said person via said terminal or kiosk at least one of (1) a rebate when there is proof of purchase of a second product item for the same product as said first product item subject to said recall but which said second product item is not subject to said recall and (2) an incentive associated with said recall such that said incentive offers a discount upon the price of a subsequent purchase of a specified product item (page 5 lines 16-21; page 6 line 32 through page 7 line 10; Figure 1 elements 10, 20, 30, 100, Figure 3 element 320).

Claim 55 defines a computer network system for recalling product items for a product subject to a recall (page 1 lines 25-26), comprising:

a computer system (page 5 line 30, Figure 1 element 10) for determining a CID associated with a product identification of said product subject to said recall (page 5 lines 30-32, Figure 1 element 20, Figure 2 element 240), thereby indicating prior purchase by a person associated with said CID of a first product item of said product subject to said recall (page 5 line 30 through page 6 line 8); and

a retail store computer system having a terminal or kiosk that is configured to respond to identification of said CID at said terminal or kiosk (page 6 lines 32-33; Figure 1 elements 10, 20, 30, 100), said CID (page 6 lines 32-33; Figure 2 element 240), thereby indicating the presence of said person at said terminal or kiosk (page 6 lines 32-33), by providing to said person via said terminal or kiosk a notification of said recall for said product and offering to said person via said terminal or kiosk at least one of (1) a rebate when there is proof of purchase of a second product item for the same product subject to said recall but which said second product item is not subject to said recall and (2) an incentive associated with said recall such that said incentive offers a discount upon the price of a subsequent purchase of a specified product item (page 5 lines 16-21; page 6 line 32 through page 7 line 10; Figure 1 elements 10, 20, 30, 100, Figure 3 element 320).

VIII. 37 CFR 41.37(C)(1)(VI) - GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

"A concise statement of each ground of rejection presented for review."

Whether the rejections of claims 3, 5, 10, 12-23, and 52-58 as obvious in view of the prior art, U.S. patent application publication 20030074272 to Knegendorf et al. (Knegendorf) and U.S. patent application publication 20030074272 to Abreu (Abreu), *and official notice*, should be reversed.

IX. 37 CFR 41.37(C)(1)(VI) - ARGUMENT

"The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."

The following sections present for review the appellants arguments for the grounds for rejection identified above and as stated by the examiner in the final office action.

X. WHETHER THE REJECTIONS OF CLAIMS 3, 5, 10, 12-23, AND 52-58 AS OBVIOUS IN VIEW OF THE PRIOR ART, U.S. PATENT APPLICATION PUBLICATION 20030074272 TO KNEGENDORF ET AL. (KNEGENDORF) AND U.S. PATENT APPLICATION PUBLICATION 20030074272 TO ABREU

(ABREU), AND OFFICIAL NOTICE, SHOULD BE REVERSED

Claims 3, 5, 10, 12-23, AND 52-58 stand rejected as obvious under 35 USC 103 based upon the teachings of U.S. patent application publication 20030074272 to Knegendorf et al. (Knegendorf) and U.S. patent application 20030074272 to Abreu (Abreu), and official notice. The appellant disagrees for the following reasons.

A. SUMMARY OF REASONING

Independent claim 3 defines "[a] ... method for recalling product items for a product subject to a recall,

comprising: ... *providing* ...at least one of

(1) a rebate when there is proof of purchase of a second product item for the same product as said first product item subject to said recall but which said second product item is not subject to said recall and

(2) an incentive associated with said recall such that said incentive offers a discount upon the price of a subsequent purchase of a specified product item.

The examiner agrees that Knegendorf and Abreu do not disclose providing (1).

The examiner agrees that Knegendorf and Abreu do not disclose providing (2).

The examiner relies upon official notice to conclude that, stripped of machine implementation, providing both (1) and (2) pre existed.

The applicant disagrees because official notice is improper and even if proved, the non machine implemented activities would not suggested the laminations of the machine implementation of (1) and (2) as defined by clam 3.

B. CLAIM CONSTRUCTION

1. Amended Claim 3

Amended claim 3 recites:

A computer network implemented method for recalling product items for a product subject to a recall, comprising:

determining, in a computer system, a CID associated with a product identification of said product subject to said recall, thereby indicating prior purchase by a person associated with said CID of a first product item of said product; and

thereafter, in response to identifying at a terminal or kiosk of a retail store computer system, said CID, thereby indicating the presence of said person at said terminal or kiosk, providing to said person via said terminal or kiosk a notification of said recall for said product and offering to said person via said terminal or kiosk at least one of (1) a rebate when there is proof of purchase of a second product item for the same product as said first product item subject to said recall but which said second product item is not subject to said recall and (2) an incentive associated with said recall such that said incentive offers a discount upon the price of a subsequent purchase of a specified product item.

2. CLAIM 3'S "(1) a rebate when there is proof of purchase of a second product item for the same product as said first product item subject to

said recall but which said second product item is not subject to said recall"

Regarding claim 3, the applicant's specification (citing to the paragraph numbers in the USPTO's publication of this application, publication number 20040267608) explains that:

[0025] The recall specification may also include terms of any refund, rebate, or incentive available from the manufacturer to be offered in association with the recall. An example of a refund is currency value in the amount of manufacturer's suggested retail price, or in the amount of price shown on proof of purchase. Examples of a rebate are (1) a check for a fixed currency amount and (2) a store voucher for a fixed discount amount upon a consumer providing proof of purchase of specified products of the manufacturer issuing the recall. More specifically, the manufacturer could offer a rebate to a consumer who had purchased a product item subject to recall upon the consumer providing to the manufacturer *proof of purchase of another product item for the same product and which is not subject to recall. An example of an incentive is a discount obtained from the retailer upon the price of a subsequent purchase of a specified product item made by the manufacturer at the time of the subsequent purchase.* [Italics added for emphasis.]

Thus, the specification explains that the system and method provide for offering a rebate *proof of purchase of another product item for the same product* as the item of the product being recalled. That is the support for claim 3's recitation "(1) a rebate when there is proof of purchase of a second product item for the same product as said first product item subject to said recall but which said second product item is not subject to said recall".

3. CLAIM 3'S "(2) an incentive associated with said recall such that said incentive offers a discount upon the price of a subsequent purchase of a specified product item"

The specification also explains that the system and method provide for offering an incentive for a *subsequent purchase in association with notification of the recall* at the POS or kiosk in the retail store. The specification states that:

[0034] In step 320, a consumer *at either a POS terminal or a kiosk in the retail store* is identified by one of the specified CIDs. The CID is entered into the *retail store's computer system*. Either the retail store's computer system or a computer system communication therewith (i.e., either another local computer system or the remote central server computer system 10) determines that the received CID is associated with the recall and transmits instructions to notify the consumer of the recall. While the consumer is interacting with the POS terminal or the kiosk, the POS terminal, the kiosk, or hardware adjacent thereto provides to the consumer notification of the recall. Notification may be in the form of a screen display, audible message, or a printed message. The notification may also include notification of terms of any refund, rebate, *or incentive*. As part of the consumer's interaction with the kiosk or POS terminal, the consumer may be provided any refund due in accordance with the recall specification.

As noted above, paragraph [0025] states in relevant part "An example of an incentive is a discount obtained from the retailer upon the price of a subsequent purchase of a specified product item made by the manufacturer at the time of the subsequent purchase." The specification clearly discloses claim 3's "that said incentive offers a discount upon the price of a subsequent purchase of a specified product item."

C. **KNEGENDORF AND ABREU**

Abreu is directed to a system for communicating product recall information. Title. Abreu discloses a central computer using a distributed computer network. Abstract. Abreu indicates that the central computer initiates electronic or other communications to affected users of, inter alia, recall notifications. Abreu paragraphs 94, 164, and 171 relate to the gathering of product information in association with a customer identifier, at a point of transaction. Knegendorf is directed to a system and method for distributing hazardous product information. Title. It also discloses providing users with fulfillment information about products for which recall notices have been issued. Abstract. Knegendorf paragraph 0004 reads:

[0004] If a particular kind of product is found to have a common flaw that is hazardous, a manufacturer may issue a product hazard information notice, in which detailed information regarding the flaw is provided and either a method of fixing the flaw is described, or consumers who purchased the product may be directed to exchange it at the place of purchase or return it to the manufacturer. This process is sometimes referred to as a "product recall," because the manufacturer is recalling the product and offers to supply the affected consumers with a safer version of the product **or** monetary compensation. [Bold and underlining added for emphasis.]

Thus, Knegendorf discloses that a product recall includes either product replacement, - - or, - - compensation to the consumer that purchased the defective product item.

D. **EXAMINER'S POSITION**

In the first office action, the examiner asserted that:

6. Regarding claim 3, Knegendorf et al teaches that product recalls typically include replacement for a safer version of the product, or compensation. Both of these are taken to meet the broad "rebate" specification.

In response, the applicant pointed out that:

Knegendorf and Abreu do not disclose the concept of associating a rebate for a non recalled item for a different product item for which a recall exists. Knegendorf and Abreu do not disclose the concept of associating an incentive for a future purchase associated with the recall notification. Therefore, they do not suggest the subject matter
[Remarks in amendment in response to first office action.]

In response, in the second and final office action, the examiner abandoned the rejection based upon Knegendorf and Abreu as disclosing (1) associating a rebate for a non recalled item for a different product item for which a recall exists and (2) associating an incentive for a future

purchase associated with the recall notification. Instead, the examiner applies official notice to assert that (1) and (2) were well known. Specifically, in the final office action, the examiner asserts the following, as fact, relying upon official notice:

However Official Notice is taken that it is notoriously well known that consumers who purchase recalled products were compensated with either vouchers (discount incentives) good for future purchase of a similar (yet safe) product or rebates refunding consumers for money spent on replacement (safe) versions of the product.

In other words, the examiner asserts facts for which there is no evidence of record. From those alleged facts, the examiner concludes:

It would have been obvious to one of ordinary skill at the time of the invention to have offered such options within the automated recall system of Knegendorf et al in view of Abreu so that consumers can be fairly made whole for the recalled product - either by known rebate techniques or discount voucher techniques.

E. RESPONSE TO EXAMINER'S POSITION

First, the examiner reliance upon official notice for novel limitations of claim 3 is improper. As stated in MPEP 2144.03.A:

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). ***

It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”). While the court explained that, “as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction,” it made clear that such “expertise may provide sufficient support for conclusions [only] as to peripheral issues.” *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697.

First, what the examiner asserts is not capable of “instant and unquestionable demonstration as being well-known” and therefore inappropriate for official notice.

Second, the applied references do not contain what the examiner alleges as fact and

reasons to have been obvious in view thereof, which is objective indicia that the examiner's assertions and conclusions are incorrect.

Third, the examiner is relying upon "'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based."

Consequently, such rejection cannot be affirmed. Zurko, supra, and In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).

Assuming *arguendo* the examiner's officially noticed facts, the rejection would still be improper. Assuming *arguendo* that it was known to provide vouchers for products for which there was a recall, that would not have suggest what is claimed. Claim 3 defines a system that integrates POS functions or transaction item logging with consumer identification, recall notification, - - and follow-on marketing associated with those consumers whose prior purchase is subject to the recall. The examiner's officially noticed facts do not disclose a terminal of a retail store computer system responding and providing the associated rebate or incentive offer. In contrast, claim 3 recites that "providing ... via said a terminal or kiosk of a retail store computer system" the associated rebate or incentive offer. Accordingly, even assuming *arguendo* the examiner's official notice as fact, the rejection is improper and should be reversed.

XII. 37 CFR 41.37(C)(1)(VIII) - CLAIMS APPENDIX

"An appendix containing a copy of the claims involved in the appeal."

The brief includes an appendix containing a copy of the claims involved in the appeal.

XIII. 37 CFR 41.37(C)(1)(IX) - EVIDENCE APPENDIX

"An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal."

The brief contains an appendix complying with the requirement for such an appendix. However, no evidence is submitted.

XIV. 37 CFR 41.37(C)(1)(X) RELATED PROCEEDINGS APPENDIX

"An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section."

The brief contains an appendix complying with the requirement for such an appendix. However, no related proceedings exist.

XV. 37 CFR 41.37(D)

The brief contains no non admitted amendment or evidence.

XVI. 37 CFR 41.37(E)

The brief is filed timely.

2-26-2009
DATE

Respectfully Submitted,
/RichardNeifeld#35,299/
Richard Neifeld
Attorney of Record
Registration No. 35,299

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CLAIMS APPENDIX

IN THE CLAIMS

- 1-2. (Canceled).
3. (Previously Presented) A computer network implemented method for recalling product items for a product subject to a recall, comprising:
determining, in a computer system, a CID associated with a product identification of said product subject to said recall, thereby indicating prior purchase by a person associated with said CID of a first product item of said product; and
thereafter, in response to identifying at a terminal or kiosk of a retail store computer system, said CID, thereby indicating the presence of said person at said terminal or kiosk, providing to said person via said terminal or kiosk a notification of said recall for said product and offering to said person via said terminal or kiosk at least one of (1) a rebate when there is proof of purchase of a second product item for the same product as said first product item subject to said recall but which said second product item is not subject to said recall and (2) an incentive associated with said recall such that said incentive offers a discount upon the price of a subsequent purchase of a specified product item.
4. (Canceled).
5. (Previously Presented) The method of claim 3 wherein the step of determining comprises determining a UPC associated with said recall.
6. (Canceled)
7. (Canceled)
8. (Canceled)
9. (Canceled)
10. (Previously Presented) The method of claim 3 transmitting a refund along with the recall notification.
11. (Canceled)
12. (Previously Presented) The method of claim 3 wherein a central server computer system performs said step of determining based at least in part on a recall specification and CIDs stored in association with data indicating prior product purchases.
13. (Previously Presented) The method of claim 3 comprising a central server computer system transmitting said determined CIDs to another computer system.
14. (Previously Presented) The method of claim 3 further comprising the step of transmitting determined CIDs associated with one retail computer system to that retailer computer system.
15. (Previously Presented) The method of claim 3 further comprising the step of

generating bar coded documents containing a determined CID and recall specification.

16. (Previously Presented) The method of claim 3 further comprising the step of accounting for return of recalled goods.

17. (Previously Presented) The method of claim 16 comprising entering into a computer system a CID associated with returned goods.

18. (Previously Presented) The method of claim 16 wherein said accounting occurs at a POS terminal in a retail store.

19. (Previously Presented) The method of claim 16 wherein said accounting occurs at a postal mail service provider facility.

20. (Previously Presented) The method of claim 3 further comprising determining the efficacy of said step of notifying.

21. (Previously Presented) The method of claim 3 further comprising accounting for costs associated with said recall.

22. (Previously Presented) The method of claim 3 further comprising target marketing to consumers associated with said determined CIDs.

23. (Previously Presented) The method of claim 22 further comprising further target re-marketing to said consumers associated with said determined CIDs depending upon consumer responses to said target marketing.

24-51. (Canceled)

52. (Previously Presented) The method of claim 3 comprising offering to said person via said terminal or kiosk said rebate.

53. (Previously Presented) The method of claim 3 comprising offering to said person via said terminal or kiosk said incentive.

54. (Previously Presented) The method of claim 3 wherein said step of providing comprises receiving at said terminal or kiosk said proof of purchase in association with said CID, thereby indicating the presence of said person at said terminal or kiosk, such that providing said rebate is in response to receipt at said terminal or kiosk from said person of said proof of purchase.

55. (Previously Presented) A computer network system for recalling product items for a product subject to a recall, comprising:

a computer system for determining a CID associated with a product identification of said product subject to said recall, thereby indicating prior purchase by a person associated with said CID of a first product item of said product subject to said recall; and

a retail store computer system having a terminal or kiosk that is configured to respond to identification of said CID at said terminal or kiosk, thereby indicating the presence of said person at said terminal or kiosk, by providing to said person via said terminal or kiosk a notification of said recall for said product and offering to said person via said terminal or kiosk at least one of (1) a rebate when there is proof of purchase of a second product item for the same product subject to said recall but which said second product item is not subject to said recall and (2) an

incentive associated with said recall such that said incentive offers a discount upon the price of a subsequent purchase of a specified product item.

56. (Previously Presented) The system of claim 55 wherein said retail store computer system is designed to offer to said person said rebate.

57. (Previously Presented) The system of claim 55 wherein said retail store computer system is designed to offer to said person said incentive.

58. (Previously Presented) The system of claim 55 wherein said terminal or kiosk is configured to receive said proof of purchase in association with said CID, thereby indicating the presence of said person at said terminal or kiosk, such that system is configured to provide said rebate is in response to receipt at said terminal or kiosk from said person of said proof of purchase.

EVIDENCE APPENDIX

No evidence.

RELATED DECISIONS APPENDIX

No related decisions.

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